

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Re PATENT APPLICATION of

**BRADSHAW et al.**

Application No. 09/664,794

Group Art Unit: 1734

Filed: September 19, 2000

Examiner: J. SELLS

Title: LAMINATING AND ADHESIVE TRANSFER APPARATUS

\* \* \* \* \*

June 17, 2002

**RESPONSE**

Honorable Commissioner of Patents,  
Washington, DC 20231

Sir:

In response to the Office Action mailed January 16, 2002, please reconsider and allow the present reissue application based on the following remarks.

**Formal Issues**

In response to the rejection based on the originally filed Reissue Declaration, a new Reissue Declaration is filed herewith.

In response to the question concerning assignee consent, a new Assignee Consent is being submitted herewith. This new Assignee Consent is signed by an officer of Xyron, Inc., the current assignee of the present application. The assignee consent provided on the original Reissue Declaration was signed by an officer of Imperial Bank, who was the assignee at the time that Reissue Declaration was prepared.

A supplemental paper providing an explanation of support for the presently pending claims is filed herewith, as requested in the Official Action.

**Substantive Issues**

Claims 36-48 currently stand rejected under §251 as being in violation of the recapture rule. The applicants respectfully request the Examiner reconsider this rejection based on the following comments.

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Admittedly, independent claims 36 and 47, the only pending independent claims, are broader in some respects than the claims issued in US 5,584,962 (the '962 patent). As noted by the Examiner, these independent claims do not recite:

pre-tensioning means integrally associated with each of said cores for selectively establishing a predetermined resistance to rotation of the rolls of feed material to provide the proper application tension for the feed material, said pre-tensioning means including a tensioning cap affixed to said associated core having an end plate engaging the associated core and said plate having with securement means engageable in said mounting means and further including biasing means for applying a predetermined force biasing said end plate into engagement with the associated core[.]

The Applicants also acknowledge that these limitations were added to claim 10 of the '962 patent, the most relevant claim to the presently claimed subject matter, for purposes of securing its allowance. However, the current reissue claim 36 is narrower than the original patent claim 10 in that it recites the "frame" as having "an outer shell including (a) a lower outer shell portion . . . and (b) an upper outer shell portion[.]" Reissue claim 36 further recites that "an upper one of said pair of cooperating pressure applying structures [is] connected with said upper shell portion[.]" Reissue claim 47 is narrower in a similar fashion, except that it recites first and second outer shell portions, instead of upper and lower shell portions. The question is whether, by securing reissue claims devoid of the above limitations, but narrowed by the addition of the limitations concerning the "outer shell", the Applicants are recapturing claim scope that was surrendered to obtain the allowance of patent claim 10.

M.P.E.P. Section 1412.02 sets forth the applicable standard for the recapture rule where the claims are broader in some aspects, but narrower in others. Specifically, this Section states "[I]f the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter." The limitations in claims 36 and 47 concerning the "outer shell portion" materially narrow the reissue claims in that they define the specific parts of the frame that move relative to one another. Original patent claim 10 was not limited in such a manner. Instead, original patent claim 10 recited an "upper frame member" and a "lower frame member," which were not limited to any specific location within the apparatus. The recitations of the upper and lower frame members in patent claim 10 would thus cover any upper and lower parts of the frame irrespective of location, whereas the use of the term "outer" in the pending reissue claims specifies a distinct location. Thus, claims 36 and 47 are materially narrower than patent claim 10, and allowing the Applicants to broaden out the claim limitations concerning the "pre-tensioning means" would not constitute

impermissible recapture because the Applicants are not regaining the same claim scope sought during prosecution of the patent.

In the Official Action, the Examiner appears to focus only on the limitations concerning the “pre-tensioning means” that are no longer recited in the independent reissue claims. However, focusing on individual limitations alone is not the proper inquiry under the recapture rule; instead, the Examiner must focus on the scope of the claims as a whole. As stated in Ball Corp. v. U.S., 729 F.2d 1429, 1437 (Fed. Cir. 1984), “[t]he proper focus is on the scope of the claims, not on the individual feature or element purportedly given up during prosecution of the original application.” Here, the Examiner has simply identified the limitations from claim 10 that are no longer present in the pending independent reissue claims, and has not focused on the other, materially narrowing changes made to the claim scope.

For the foregoing reasons, it is submitted that the recapture rule does not apply and withdrawal of the rejection based on it is respectfully requested.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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